

FORM PTO-1390  
(REV. 01-2003)

U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE

ATTORNEY'S DOCKET NUMBER

04661/HG

TRANSMITTAL LETTER TO THE UNITED STATES  
DESIGNATED/ELECTED OFFICE (DO/EO/US)  
CONCERNING A FILING UNDER 35 U.S.C. 371

U.S. APPLICATION NO. (If known, see 37 CFR 1.5

10/509549

INTERNATIONAL APPLICATION NO.  
PCT/JP03/03928INTERNATIONAL FILING DATE  
28 March 2003PRIORITY DATE CLAIMED  
29 March 2002

## TITLE OF INVENTION

k opioid Receptor Agonist Comprising 2-Phenylbenzothiazoline Derivative

APPLICANT(S) FOR DO/EO/US Maki TOKAI; Takahiro HONDA; Masashi NIWA; Yaeko OSUMI;  
Ken-ichi FUJIMURA; Shin-ichi KOHNO

Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:

1. ☒ This is a **FIRST** submission of items concerning a filing under 35 U.S.C. 371.
2. ☐ This is a **SECOND** or **SUBSEQUENT** submission of items concerning a filing under 35 U.S.C. 371.
3. ☒ This is an express request to begin national examination procedures (35 U.S.C. 371(f)). The submission must include items (5), (6), (9) and (21) indicated below.
4. ☒ The US has been elected (Article 31).
5. ☒ A copy of the International Application as filed (35 U.S.C. 371(c)(2))
  - a. ☐ is attached hereto (required only if not communicated by the International Bureau).
  - b. ☒ has been communicated by the International Bureau.
  - c. ☐ is not required, as the application was filed in the United States Receiving Office (RO/US).
6. ☒ An English language translation of the International Application as filed (35 U.S.C. 371(c)(2)).
  - a. ☒ is attached hereto.
  - b. ☐ has been previously submitted under 35 U.S.C. 154(d)(4).
7. ☐ Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371(c)(3))
  - a. ☐ are attached hereto (required only if not communicated by the International Bureau).
  - b. ☐ have been communicated by the International Bureau.
  - c. ☐ have not been made; however, the time limit for making such amendments has NOT expired.
  - d. ☐ have not been made and will not be made.
8. ☐ An English language translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371 (c)(3)).
9. ☒ An oath or declaration of the inventor(s) (35 U.S.C. 371(c)(4)).
10. ☐ An English language translation of the annexes of the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. 371(c)(5)).

## Items 11 to 20 below concern document(s) or information included:

11. ☐ An Information Disclosure Statement under 37 CFR 1.97 and 1.98.
12. ☒ An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.
13. ☒ A preliminary amendment.
14. ☐ An Application Data Sheet under 37 CFR 1.76.
15. ☐ A substitute specification.
16. ☒ A change of correspondence address (Form PTO/SB/122)
17. ☐ A computer-readable form of the sequence listing in accordance with PCT Rule 13ter.2 and 37 CFR 1.821 - 1.825.
18. ☐ A second copy of the published international application under 35 U.S.C. 154(d)(4).
19. ☐ A second copy of the English language translation of the international application under 35 U.S.C. 154(d)(4).
20. ☒ Other items or information:

## (a) REQUEST FOR PUBLICATION OF ASSIGNMENT INFORMATION

- (b) copy of Form PCT/IB/301 for PCT/JP03/03928
- (c) copy of Form PCT/IB/304 for PCT/JP03/03928
- (d) copy of Form PCT/IB/308 for PCT/JP03/03928
- (e) copy of Form PCT/IB/332 for PCT/JP03/03928
- (f) copy of the first page of WO 03/082840, the published application of PCT/JP03/03928
- (g) copy of Form PCT/ISA/210, the International Search Report (in English) for PCT/JP03/03928

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No.: EV 443 226 855 US

Date of Deposit: September 28, 2004

I hereby certify that this paper is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

*Dorothy DeFrancesco*  
Dorothy DeFrancesco

U.S. APPLICATION NO. 10/509549

INTERNATIONAL APPLICATION NO.  
PCT/JP03/03928ATTORNEY'S DOCKET NUMBER  
04661/HG21. ☒ The following fees are submitted:**BASIC NATIONAL FEE (37 CFR 1.492 (a) (1) - (5)):**Neither international preliminary examination fee (37 CFR 1.482)  
nor international search fee (37 CFR 1.445(a)(2)) paid to USPTO  
and International Search Report not prepared by the EPO or JPO. .... \$1080.00International preliminary examination fee (37 CFR 1.482) not paid to  
USPTO but International Search Report prepared by the EPO or JPO ..... \$920.00International preliminary examination fee (37 CFR 1.482) not paid to USPTO  
but international search fee (37 CFR 1.445(a)(2)) paid to USPTO ..... \$770.00International preliminary examination fee (37 CFR 1.482) paid to USPTO  
but all claims did not satisfy provisions of PCT Article 33(1)-(4) ..... \$730.00International preliminary examination fee (37 CFR 1.482) paid to USPTO  
and all claims satisfied provisions of PCT Article 33(1)-(4) ..... \$100.00**ENTER APPROPRIATE BASIC FEE AMOUNT =****CALCULATIONS PTO USE ONLY**

\$ 920.00

Surcharge of \$130.00 for furnishing the oath or declaration later than 30 months  
from the earliest claimed priority date (37 CFR 1.492(e)).

\$

CLAIMS	NUMBER FILED	NUMBER EXTRA	RATE	\$
Total claims	29 - 20 =	9	x \$18.00	\$ 162.00
Independent claims	5 - 3 =	2	x \$86.00	\$ 172.00
MULTIPLE DEPENDENT CLAIM(S) (if applicable)				\$ 290.00
<b>TOTAL OF ABOVE CALCULATIONS =</b>				\$1,544.00

☐ Applicant claims small entity status. See 37 CFR 1.27. The fees indicated above  
are reduced by 1/2.

\$

**SUBTOTAL =**

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Processing fee of \$130.00 for furnishing the English translation later than 30 months  
from the earliest claimed priority date (37 CFR 1.492(f)).

\$

**TOTAL NATIONAL FEE =**

\$

Fee for recording the enclosed assignment (37 CFR 1.21(h)). The assignment must be  
accompanied by an appropriate cover sheet (37 CFR 3.28, 3.31). \$40.00 per property +

\$

**TOTAL FEES ENCLOSED =**

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Amount to be  
refunded:

\$

charged:

\$

a. ☒ A check in the amount of \$ 1,584.00 to cover the above fees is enclosed.b. ☐ Please charge my Deposit Account No. \_\_\_\_\_ in the amount of \$ \_\_\_\_\_ to cover the above fees.  
A duplicate copy of this sheet is enclosed.c. ☒ The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any  
overpayment to Deposit Account No. 06-1378. A duplicate copy of this sheet is enclosed.d. ☐ Fees are to be charged to a credit card. **WARNING:** Information on this form may become public. Credit card  
information should not be included on this form. Provide credit card information and authorization on PTO-2038.**NOTE:** Where an appropriate time limit under 37 CFR 1.495 has not been met, a petition to revive (37 CFR 1.137 (a)  
or (b)) must be filed and granted to restore the application to pending status.SEND ALL CORRESPONDENCE TO:  
FRISHAUF, HOLTZ, GOODMAN & CHICK, P.C.  
767 Third Avenue - 25<sup>th</sup> Floor  
New York, NY 10017-2023**CUSTOMER NO: 01933**

Tel. No. (212) 319-4900

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SIGNATURE

Richard S. Barth

NAME

28,180

REGISTRATION NUMBER

Date: September 28, 2004

**IN THE UNITED STATES PATENT  
AND TRADEMARK OFFICE**

Applicants : Maki TOKAI et al.  
Serial No. : To be assigned (U.S. National  
Phase of PCT/JP03/03928)  
Filed : Concomitantly Herewith  
For :  $\kappa$  opioid Receptor Agonist  
Comprising 2-Phenylbenzo-  
thiazoline Derivative  
Docket No. : 04661/HG  
Customer No.: 01933

**REQUEST FOR PUBLICATION OF  
ASSIGNMENT INFORMATION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

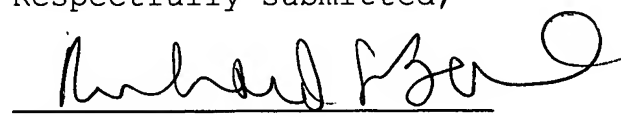
**ATTENTION: MAIL STOP PCT**

S I R :

It is requested that the following assignment information be published as part of the 18-month publication of the present application:

SANTEN PHARMACEUTICAL CO., LTD.  
9-19, Shimoshinjo 3-chome, Higashiyodogawa-ku,  
Osaka-shi, Osaka 533-8651 Japan .

Respectfully submitted,

  
Richard S. Barth  
REG. NO. 28,180

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Fax No. (212) 319-5101  
E-Mail Address: BARTH@FHGC-LAW.COM  
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Dorothy DeFrancesco

In the event that this Paper is late  
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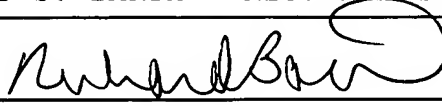
DT Spec'd PCT/PTO 28 SEP 2004

PTO/SB/122 (10-00)

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<b>CHANGE OF CORRESPONDENCE ADDRESS</b>  <b>Application</b>  <b>Address to:</b> <b>Commissioner for Patents</b> <b>P.O. Box 1450</b> <b>Alexandria, VA 22313-1450</b>	Application Number		To be assigned (U.S. National Phase of PCT/JP03/03928)	
	Filing Date		Concomitantly Herewith	
	First Named Inventor		Maki TOKAI	
	Group Art Unit			
	Examiner Name			
	Attorney Docket Number		04661/HG	
Please change the Correspondence Address for the above-identified application to: <input checked="" type="checkbox"/> Customer Number [ 01933 ] → Type Customer Number here OR				
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Typed or Printed Name RICHARD S. BARTH - REG. NO. 28,180				
Signature 				
Date September 28, 2004				
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required. See below.				
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